

REMARKS

Independent claims 1, 74 and 78 have been amended to recite that the first and second oligonucleotides are "single stranded", support for which is contained e.g., in Paragraph [0006] in the present specification. Claim 1 has also been amended to include the recitation in Claim 28. Thus, it now recites that the first and/or second analyte-specific binding entity is a protein "or a protein complex." Claim 28 has been cancelled. Claim 20 has been amended for purposes of clarification. Claim 22 has been amended to parallel the language of Claim 23. Claim 23 has been amended to depend from Claim 1. Claim 74 (ii) has also been amended by changing to the recitation "at least one" to "a". Claim 76 has been cancelled, as it appears directed to a non-elected invention. Thus, no new matter has been added. Thus, entry of the amendments is respectfully requested.

Claim Objections

Claim 20 has been objected to on the ground that a comma should be inserted between the recitations "oligonucleotide" and "wherein", in line 5. Applicants' amendment to claim 20 is believed to render this objection moot.

Claim 23 has been objected to under 37 C.F.R. § 1.75(c) as improper in that it contains the same limitations recited in claim 22.

Claim 23 has been amended to depend from claim 1. Regardless, Applicants submit that it is not duplicative with claim 22 in that it recites that the hybridization blocker oligonucleotide reduces formation of the amplicon by a factor of at least "1000-fold", whereas the pertinent recitation in claim 2 is "at least 100-fold."

Reconsideration and withdrawal of the objections are respectfully requested.

Claim 76 has been rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Applicants respectfully submit that in view of the cancellation of Claim 76, this rejection is rendered moot.

Claims 1-8, 10-14, 20-30, 74, 76, and 78 have been rejected under § 112, second paragraph, as indefinite on various grounds. Each of these grounds of rejection will be addressed in turn.

Claims 1 and 74 are alleged to be unclear as to why the 3' terminus of the first or second oligonucleotide can be extended and an amplicon be produced if, in step (iii) does not require that the 5' portion of the first or second oligonucleotide in the hybrid is single stranded, thus creating the possibility that the first or second oligonucleotide in the hybrid is double-stranded.

Claims 1 and 74 have been amended to recite that the first and second oligonucleotides are "single stranded". This newly added recitation, coupled with the extant recitation that the hybrid comprises "a 3' terminus of the first or second oligonucleotide that may be extended," makes it clear to a person skilled in the art, as to how an amplicon may be produced.

Although Claim 78 is included in the rejection, the Office action is silent as to exactly why it is believed to be vague and indefinite. Claim 78 has also been amended include this recitation.

Claim 20 is alleged to be unclear in the meaning of the phrase "displacing in step (iv) the second hybridization blocker oligonucleotide." Applicants' amendment to claim 20 is believed to adequately address this ground of rejection.

Claim 22 is alleged to be unclear in that since claim 1 requires to displace the hybridization blocker

oligonucleotide before producing the amplicon, and does not require to produce the amplicon in the presence of the hybridization blocker oligonucleotide, it is unclear how the hybridization blocker oligonucleotide can reduce formation of the amplicon by hybridization of the first and second oligonucleotides prior to forming said complex by a factor of at least 100-fold.

Applicants have amended claim 22 by deleting the recitation "by hybridization of the first and second oligonucleotides prior to forming said complex." Thus, claim 22 reads identically to claim 23 (which is not specifically objected to in this respect).

Claim 28 has been rejected as vague and indefinite in that the recitation of a "protein complex" renders this claim much broader than the "protein" recited in claim 1. Claim 1 has been amended to introduce the limitation of claim 28. Accordingly, claim 28 has been cancelled. The Examiner's suggestion with respect overcoming this ground of rejection is appreciated.

Claim 24 has been rejected as vague and indefinite in that since step (ii) does not require that the 5' portion of the first oligonucleotide in the hybrid is single stranded, if the 5' portion of the first oligonucleotide in the hybrid is double stranded, it is unclear why the 3' terminus of the second oligonucleotide can be extended and an amplicon be produced.

Applicants respectfully traverse this ground of rejection. They are at a loss to appreciate the relevance of the strandedness of the first and second oligonucleotides. On the other hand, what is believed to be clear, particularly when the claims are read in light of the specification, which they must, is that there is no recitation in claim 74 that the second portion of the first oligonucleotide is complexed or hybridized,

and thus would provide a template for the extension of the 3' terminus of the second oligonucleotide.

Claims 74 or 76 has been rejected as vague and indefinite in that since step (i) only contains a first oligonucleotide and a second oligonucleotide wherein the first portion of the first oligonucleotide is capable of hybridizing to the first portion of the second oligonucleotide, after combining the analyte, the first proximity member and the second proximity member, only one hybrid comprising the first portion of the first oligonucleotide and the first portion of the second oligonucleotide can be formed, and that since the recitation "at least one hybrid" in step (ii) means one kind or more than one kind of hybrids, it is unclear why more than one kind of hybrids comprising the first portion of the first oligonucleotide and the first portion of the second oligonucleotide can be formed in view of step (a). Applicants respectfully traverse this rejection.

In view of the cancellation of Claim 76, Applicants submit that the rejection is moot to the extent this claim is actually rejected. There is no recitation in claim 74 of "kind." In addition, there is no disclosure in the specification that warrants such an interpretation, particularly in view of the cancellation of Claim 76. In any event, to the extent the Examiner prefers an alternative recitation claim 74 has been amended by deleting the phrase "at lease one" and inserting the recitation "a." This term is being used in its legally accepted meaning, which is "one or more" or "at least one." Thus, the claim positively recites what "a" complex in step (ii) contains. Regardless of what other types or kinds of complexes might actually be formed, Applicants respectfully submit that the claim does not have to be close-ended as to those, but rather positively recite a complex that is formed during the course of the claimed method.

Reconsideration and withdrawal of all grounds of rejection are respectfully requested.

As it is believed that all of the rejections set forth in the Official Action have been fully met, favorable reconsideration and allowance are earnestly solicited.

If, however, for any reason the Examiner does not believe that such action can be taken at this time, it is respectfully requested that he/she telephone applicant's attorney at (908) 654-5000 in order to overcome any additional objections which he might have.

If there are any additional charges in connection with this requested amendment, the Examiner is authorized to charge Deposit Account No. 12-1095 therefor.

Dated: February 8, 2010

Respectfully submitted,
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